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10/089,996	04/05/2002	Tatsuji Nagaoka	9683/112	5819
7590 11/20/2006			EXAMINER	
Brinks Hofer Gilson & Lione P O Box 10395 Chicago, IL 60610			LE, KHANH H	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 11/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/089,996

Applicant(s)

NAGAOKA ET AL.

Examiner

Khanh H. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 18-43, 45, 46 and 48-55 is/are pending in the application.
- 4a) Of the above claim(s) 21-23, 31-43, 45, 46, 48-53 and 55 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                                  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/17/06; 10/10/06</u> . | 6) <input type="checkbox"/> Other: _____   |

### Detailed Action

1. This Office Action is in response to the correspondence received September 8, 2006. Claims 18-43, 45-46, 48-55 are now presented for examination. Claims 18, 31 and 43 are independent. Claims 54-55 are new.

### Response to Arguments

2. As to Applicants' arguments pertaining to the restriction requirements, Applicants' election with traverse of the group I and II is acknowledged.

Notwithstanding the several limitations common to the independent claims as argued, as stated earlier, the rationales for restricting inventions I, II and III are still deemed proper and the requirements are therefore made final.

For example, the following rationale for restricting inventions I and II is still deemed proper. Applicants are referred to the last Office Action for the rationales as to invention III.

***"I. Claims 18-30 , drawn to a mobile terminal, classified in class 348, subclass 14.05 or 379.***

***II. Claim 31-42 , drawn to a method for distributing service incentive to a mobile terminal, classified in class 705, subclass 14.***

***.....Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)).***

***In this case invention I, the mobile terminal (such as a PDA ) comprising interactive device interface to communicate with an interactive device ( such as a television receiver) with***

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*interactive device control (e.g. software ) to control reception of broadcast and other information via the interactive device (e.g. television receiver) to the mobile terminal and user interface (e.g. buttons) to send user requests, and mobile communication network interface to communicate with a service facility, can be used to practice another and materially different process such as to send any type of requests , to any type of facility, and not just the requests to a management system for receipt of incentive information in relation to the broadcast information as claimed in invention II. Apparatus invention I can also be used to practice another and materially different process such as receiving any other type of information and not just a promoted service based on a broadcast information and subsequent request to a particular incentive information management system as claimed in method invention II.*

*Because inventions I and II are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper."*

Further, the search for claims of Group I would require a different search than the search for claims of Group II and the Examiner asserts it is a burden for the Examiner to conduct the separate searches.

It is noted Applicants do not argue why the further restrictions based on species are improper.

As Applicants elect prosecution of Group IA1, consisting of claims 18, 19, 20, 24-30, claims 21, 22-23, 31-43, 45-46, 48-53 are withdrawn from further consideration by the Examiner. As to the new claims 54 and 55, claim 54 depends on claim 18 and therefore is hereby examined. Claim 55 depends on withdrawn independent claim 31 thus is also withdrawn.

**In summary, claims 18, 19, 20, 24-30, 54 are now examined and claims 21, 22-23, 31-43, 45-46, 48-53, 55 are withdrawn.**

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

**3. With respect to arguments as to prior art applied (see Applicants' Response received May 18, 2006).**

As to Crosby, the rejection is withdrawn.

As to Meyer, Applicant's arguments have been fully considered but they are not persuasive. Contrary to argument (Applicants argue Meyer is silent about broadcasting), Meyer implies at least television broadcast signals for receipt by the user computer which can be an interactive television, a television receiver with other display facility, a television set-top box (col. 18 lines 1-18). Meyer also discloses a set-top box (STB) (interactive device). See col. 18 lines 1-18. (Meyer ' user mobile terminal ( above cited appliances and also intelligent telephone) is also described in expansive terms : "or any combination of multiple computers" (col. 18 lines 8-18))

#### **Claim objections**

**4. Withdrawn as moot.**

#### **Claim Rejections - 35 USC § 112 Second Paragraph**

**5. The following is a quotation of the second paragraph of 35 U.S.C. 112:**

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**6. Claims 26, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

As to claims 26, it is not clear how “the incentive information from the management system” can comprise “a request requesting the service facility to render the promoted service”.

For prior art application this is interpreted as the incentive information comprise incentives for a free service that can be requested of the service facility (per a conversation with Mr. Tadashi Horie, Applicants’ representative, on January 4, 2006). However, Applicants have not pointed out to specific support for this limitation as so interpreted).

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**8. Claim 26 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one**

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**skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.**

Claim 26: Support has not been found for the claim 26 as amended. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**10. Claims 18, 19, 20, 24-30, 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meyer et al., US 6915271 in view of Ozawa et al., US 7023858 B2.**

As to claim 18, Meyer discloses:

A mobile terminal ( Fig. 1 item 115, consumer device, and associated text; col. 18 lines 1-34: TV set –top box or intelligent telephone or any combination of multiple computers ) for use in a broadcasting system comprising a broadcast station , the mobile terminal comprising: an interactive device (STB)(Fig.1. item 115: col. 18 lines 34: TV set –top box )

for receiving broadcast information from the broadcast station (see , abstract, Fig.1 and associated text) and a management system (see Fig. 1 item 105: incentive information computer),

the mobile terminal comprising:

a user interface ( inherent, e.g. a mouse to permit selecting/ clipping coupons , see Fig 2 and associated text) that interacts with a user of the mobile terminal to generate a user request in relation to the broadcast information , wherein the user request is receivable by the management system so that the mobile terminal receives from the management system incentive information

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for promoting a service (see at least abstract; Figs. 1-2 and associated text: coupons and other ads etc; transactions after receiving coupons, ads ); and

mobile communication network interface (inherent to support intelligent telephone systems connected to the internet, see col.18 line 6) that communicates via a mobile communication network (inherent to support intelligent telephone systems connected to the internet, see col.18 line 6) with a service facility that provides the service in order to receive the service from the service facility (see Fig. 1, item 117 and associated text: user connects to e-commerce sites provided to conduct service transactions; see Figs. 1-3 and associated text).

Meyer does not specifically disclose the interfaces details such as  
an **interactive device interface** specifically configured to communicate with an interactive device (STB) for receiving broadcast information from the broadcast station; and

an **interactive device control** configured to instruct the interactive device via the interactive device interface to control reception and reproduction of the broadcast information by the interactive device and forwarding of selected information in the broadcast information to the mobile terminal from the interactive device

However Ozawa discloses all such.

Ozawa discloses:

a mobile terminal (devices interacting with set-top box ( see Fig. 1 items 22 (STB) ) such as remote control, internet appliances, personal digital assistant, laptop computer, keyboard or computer mouse or an input device in the form of a control panel located on the TV 24 or the STB 22 of Fig. 1 ) see Fig. 1 items 28, 36, col. 4 lines 37-63 )

for use in a broadcasting system comprising a broadcast station , the mobile terminal comprising:



interactive device (STB) interface specifically configured to communicate with an interactive device (STB) (Fig. 1 items 34, 30: STB I/O interfaces, and associated text, Fig. 2 items 146, 150 to 166; col. 4 lines 37-63) for receiving the broadcast information from the broadcast station (Fig 1 item 10: head end) ;

interactive device control (hardware and software layers, see col. 8 lines 5-40) configured to instruct the interactive device (STB) via the interactive device interface to control reception and reproduction of the broadcast information by the interactive device and forwarding of selected information in the broadcast information to the mobile terminal (“selected information in the broadcast information” is interpreted for example as a particular show from a particular TV channel chosen by the user) from the interactive device (STB)

user interface (e.g. buttons are inherent in remote controls or PDA's, or mouse for a user computer) configured to interact with a user of the mobile terminal to generate a user request in relation to the broadcast information, wherein the user request is receivable by a (management) system so that the mobile terminal receives from the (management) system incentive information for promoting a service (col.3 lines 30-34: broadcast of ads, ads usually promotes services or products);

It would have been obvious to one skilled in the art at the time the invention was made to add the above structural interface details to Meyer in order to allow carrying out the functions of the user mobile terminal and the STB disclosed in Meyer.

*(Note Ozawa also discloses*

*mobile communication network interface (Fig. 1 item 20:*

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*bidirectional link to Fig1, items 38, 44, 48 :ISP host, internet) configured to communicate via a mobile communication network (Fig1, items 38, 44 :ISP host, internet) with a service facility Fig1, items 38, 48 :ISP host, internet servers) that provides the service in order to receive the promoted service (video-on-demand) from the service facility.)*

As to claims 19, Meyer/OZAWA discloses wherein the user request is sent to the management system via the interactive device at an instruction from the mobile terminal ( Fig. 1 item 115, consumer device, and associated text; col. 18 lines 1-34: TV set –top box or intelligent telephone or any combination of multiple computers ).

As to claims 20, Meyer/Ozawa discloses wherein the incentive information is received by the interactive device interface via the interactive device at an instruction from the mobile terminal (Meyer's user receives incentives via the internet interface (Fig. 3) and implicitly uses the interface and the coupons provided for further transactions via the internet-linked mobile unit).

As to claims 24, MEYER discloses a memory (see at least Fig. 2 item 211 and associated text) for storing personal information, wherein the personal information is communicated to the management system (see at least col.6 lines 44-66 ), along with the user request (see at least Fig. 2 and associated text).

As to claims 25, MEYER discloses wherein the user request comprises a form (see at least Figs.7-10 and associated text; col. 8 line 38 to col. 10 line 62; webpage as a form that a user can manipulate), and the user interface comprises a keypad for inputting data (inherent in intelligent user device) into the form.

As to claims 26, Meyer discloses the incentive information from the management system comprises incentives for a free service that can be requested of the service facility (see at least col. 7 line 38).

As to claims 27, MEYER implicitly discloses wherein the incentive information from the management system comprises a redeemable promotion for the service from the service facility (see at least abstract; Figs. 1-3, coupons are provided then links to e-commerce sites are provided implicitly to use the coupons thereat )

As to claims 28, MEYER discloses wherein the user request comprises a qualification for the incentive information. (Fig. 2, item 205 and associated text: shows a webpage where coupons are available to users if the users select them and based on consumer data). In MEYER, the incentive information generator determines, based on the qualification if the user qualifies for the incentive information (Fig. 2, item 205 and associated text: shows a webpage where coupons are available to users if the users select them and based on consumer data).

As to claims 29, Meyer discloses online redemption of e-incentives by communicating at least a part of the incentive information to the service facility, after receiving the incentive information, by the mobile communication network interface , via the mobile communication network in case a mobile user device such as an intelligent telephone is used. (see abstract, Figs 1-3 and associated text, col. 18 lines 1-18).

As to claim 30, Meyer discloses wherein the receiver comprises a set-top box, and the receiver interface comprises a set-top box interface (see at least col. 18 lines 1-18).

As to claim 54, Meyer/OZAWA discloses the user request and the incentive information are transmittable via either the interactive device or the mobile communications network (see Meyer, col.18 line 6; see Fig. 1, item 117 and associated text: user connects to e-commerce sites provided to conduct service transactions; see Figs. 1-3 and associated text).

***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ichihashi et al. US 6075527 discloses remote control operation with interactive TV (col. 19 line 56 to col. 20 line 65; col 22 lines 5-67; figs 1, 23, 30-39).

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 571-272-6721. The Examiner works a part-time schedule and can normally be reached on Tuesday-Wednesday 9:00-6:00.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone numbers for the organization where this application or proceeding is assigned are **571-273-8300** for regular

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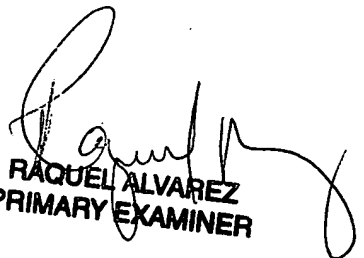
communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600. For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

November 13, 2006



KHL



RAQUEL ALVAREZ  
PRIMARY EXAMINER